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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,357	07/13/2006	Basil D. Favis	055189-0014	8299
20572 7590 08/07/2008 GODFREY & KAHN S.C. 780 NORTH WATER STREET MILWAUKEE, WI 53202				
EXAMINER				
ELLIS, SUEZU Y				
ART UNIT		PAPER NUMBER		
1615				
MAIL DATE		DELIVERY MODE		
08/07/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,357

Applicant(s)

FAVIS ET AL.

Examiner

Suezu Ellis

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-42 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF 298)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 2-5, drawn to a microporous biodegradable polymeric article, including the specifics of the pore diameters.

Group II, claim(s) 6, drawn to a microporous biodegradable polymeric article, including the specifics of the porosity.

Group III, claim(s) 1, 7 and 8, drawn to a microporous biodegradable polymeric article, including the specifics of the morphology of the article.

Group IV, claim(s) 1 and 9, drawn to a microporous biodegradable polymeric article, including the specifics of the article having a closed-cell skin.

Group V, claim(s) 1, 10-12, drawn to a microporous biodegradable polymeric article, including the specifics of the polymer.

Group VI, claim(s) 14, 15-17, drawn to the particulars of a method of preparation of a microporous biodegradable polymeric article, including the specifics of polymer A.

Group VII, claim(s) 14, 18-20, drawn to the particulars of a method of preparation of a microporous biodegradable polymeric article, including the specifics of polymer B.

Group VIII, claim(s) 14, 21 and 22, drawn to the particulars of a method of preparation of a microporous biodegradable polymeric article, including the specifics of compatibilizer C

Group IX, claim(s) 14, 24 and 25, drawn to the particulars of a method of preparation of a microporous biodegradable polymeric article, including the specifics of the polymer blend.

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Group X, claim(s) 14, 26 and 33, drawn to the particulars of a method of preparation of a microporous biodegradable polymeric article, including the specifics of steps between steps b) and c)

Group XI, claim(s) 14, 27 and 34, drawn to the particulars of a method of preparation of a microporous biodegradable polymeric article, including the specifics of steps during step c)

Group XII, claim(s) 14 & 35, drawn to the particulars of a method of preparation of a microporous biodegradable polymeric article, including the specifics of steps after step d)

Group XIII, claim(s) 14 & 36, drawn to the particulars of a method of preparation of a microporous biodegradable polymeric article, including the specifics of steps between steps c) and d)

Applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claim 13 will be examined with the elected invention only if one of inventions I-IX is elected. Claim 37, 39 and 41 will be examined with the elected invention only if one of inventions I-V is elected. Claim 38, 40 and 42 will be examined with the elected invention only if one of inventions V-IX is elected.

The inventions listed as Groups I-XIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

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The common feature among all the Groups is a microporous biodegradable article comprising an essentially continuous porosity with a void volume from 10-90%, wherein pore diameters show a unimodal distribution set to a predefined unimodal peak location corresponding to a chosen pore diameter, and wherein a majority of pores has a diameter within $\pm 50\%$ of the chosen pore diameter. This feature is shown, either singly or in combination, in US 6,511,511 (see Fig. 7B, col. 3, line 47 – col. 4, line 7), lack novelty or an inventive step and do not contribute over the prior art.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species for invention X are as follows:

- x_a. The polymer blend is submitted to controlled annealing between steps (b) and (c)
- x_b. The polymer blend is shaped in a mold or die between steps (b) and (c)
- x_c. The polymer blend is shaped via injection molding between steps (b) and (c)
- x_d. The polymer blend is formed by extrusion between steps (b) and (c)
- x_e. The polymer blend is formed by melt spinning between steps (b) and (c)
- x_f. The polymer blend is submitted to controlled annealing between steps (b) and (c)

The species for invention XI are as follows:

- x_{ia}. The polymer blend is submitted to controlled cooling rates in step (c)
- x_{ib}. The polymer blend is submitted to a mechanical stress in step (c)

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

The species for invention X are as follows:

- x_a. claim 26
- x_b. claims 28, 29
- x_c. claims 28, 30
- x_d. claims 28, 31
- x_e. claims 28, 32
- x_f. claim 33

The following claim(s) are generic for Inventions X: claim 14

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The species for invention XI are as follows:

xi_a. claim 27

xi_b. claim 34

The following claim(s) are generic for Inventions XI: claim 14

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

The special technical feature in Group X and XI is a process for forming a microporous biodegradable article comprising an essentially continuous porosity with a void volume from 10-90%, wherein pore diameters show a unimodal distribution set to a predefined unimodal peak location corresponding to a chosen pore diameter, and wherein a majority of pores has a diameter within $\pm 50\%$ of the chosen pore diameter. This feature is shown, either singly or in combination, in US 6,511,511 (see Fig. 7B, col. 3, line 47 – col. 4, line 7) and US 4,822,678, lack novelty or an inventive step and do not contribute over the prior art.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Telephone/Fax Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suez Ellis whose telephone number is (571) 272-2868. The examiner can normally be reached on 8:30am-5pm (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharon Kennedy can be reached on (571) 272-4948. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SE

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615